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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 91125615

Serial No. 75/358,031

Mark: SC (Stylized)

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OPPOSER'S SEPARATE STATEMENT OF OBJECTIONS

Opposer objects to certain evidence introduced by Applicant in this proceeding as set forth herein. This Statement comprises objections to Applicant's witnesses' trial testimony, exhibits filed in connection with trial testimony, documents submitted by Applicant in its notices of reliance, and facts in the parties' stipulation of facts (wherein the parties reserved the right to make relevance objections). The following Table of Contents summarizes the topics of Opposer's objections.

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I.
OPPOSER'S EVIDENTIARY OBJECTIONS TO TRIAL TESTIMONY
ELICITED FROM CAROLINA'S WITNESSES

Opposer the University of Southern California ("Opposer" or "California") asserts the following objections to trial testimony elicited from Elizabeth West, Kenneth Corbett, and C. "Kit" Walsh, all witnesses for the University of South Carolina ("Applicant" or "Carolina").

A. Objections to Testimony Deposition of Elizabeth West ("TD-West")

1. Objectionable Testimony: TD-West 5:23-6:8, 6:23-7:15, 22:4-17, 46:9-11, 47:6-50:9 (Alleged Historical Use by Carolina of the Letters "SC")

Over repeated objection, Carolina sought to elicit testimony from its University Archivist, Elizabeth West, about the alleged historical uses of the letters "SC" by South Carolina. However, Ms. West testified that any knowledge she possessed was merely gleaned from documents in the possession of Carolina that either were or could have been part of the record in this case. [TD-West 49:25-50:9, 53:7-54:1 (her opinions were based on research as an archivist and all documents upon which she had relied were maintained in archives and could be provided to the Board.)] In other words, Ms. West was merely attempting to characterize documents that either were of record or could have been of record. Ms. West was not designated as an expert. California objects to this conclusory testimony on the following legal grounds:

- **Best Evidence/Documents Speak for Themselves.** Since Ms. West was merely attempting to describe or draw conclusions from documents in the possession of a party, the documents would be the best evidence of their contents.
- **Hearsay.** To the extent that Ms. West was relying on any third party's description of the use of any form of the "SC" mark (*e.g.*, relying on any statement in any history of the University of South Carolina), Ms. West's testimony would be hearsay about hearsay. [*Compare* TD-West 7:17-8:17 (testimony by Ms. West about the "rat hat") with TD-West 25:3-12 (admission from Ms. West that she had no personal knowledge and was relying on materials she had read).]

- Improper Expert Opinion.

2. Objectionable Testimony: TD-West 9:6-18, 11:10-12:6, 13:5-10, 14:3-8, 15:6-14, 16:9-17, 17:9-19, 18:11-16, 19:8-13, 45:9-13 (Description of Documents in the Record)

Over repeated objection, Carolina sought to elicit descriptions of the contents of photographs. As an archivist, Ms. West is competent to authenticate the documents (which documents were stipulated authentic in any event). However, Ms. West has no personal knowledge of the events at issue in the photographs, which make her testimony on such photographs no more useful than the photographs themselves. [TD-West 19:21:-21:14.] California objects to this testimony on the following legal grounds:

- Best Evidence/Documents Speak for Themselves. Since Ms. West was merely describing documents which are themselves submitted to the Board, the documents are the best evidence of their contents.
- Lack of Foundation/No Competence. To the extent that Ms. West was seeking to add anything to the documents themselves, Ms. West has no personal knowledge that would provide any background.

B. Objections to Testimony Deposition of Kenneth Corbett (“TD-Corbett”)

1. Objectionable Testimony: TD-Corbett 43:3-55:5 (Testimony Regarding Websites of Third Party Educational Institutions)

Over repeated objection, Carolina sought to elicit testimony about the content of third party websites from Kenneth M. Corbett, Carolina’s Director of Capital Finance/Director of Licensing. California had stipulated to the authenticity of the documents as coming from such websites. [TD-Corbett 44:3-11.] Mr. Corbett testified that he had no other knowledge about events at the institutions other than having visited the websites and having reviewed the materials already identified on the record. [*Id.* 55:16-20.] Mr. Corbett did not know whether the schools at issue were two year or four year schools, or whether anyone ever referred to those institutions verbally as “SC.” [*Id.* 55:21- 62:9.] Mr. Corbett was not designated as an expert. California objects to this testimony on the following legal grounds:

- Best Evidence/Documents Speak for Themselves. Since Ms. Corbett was merely attempting to describe or draw conclusions from documents attached to the record, the testimony itself is objectionable and should be stricken. To the extent relevant, the documents would be the best evidence of their contents.
- Irrelevant. The fact that third parties may have used similar marks in very different settings is essentially irrelevant without information about the extent of their use. As the Board has held:

We see some other problems which limit the probative value of the evidence of third-party use. Many of the marks being used are less similar to opposer's marks than are applicant's marks. Further, applicant has not furnished any evidence regarding the extent of use of the marks by these third parties. The geographic locations of these restaurants, in many instances, are relatively obscure. Moreover, the pictures of these restaurants tend to indicate that the operations are small and local in nature.

Carl Karcher Enterprises Inc. v. Star Restaurants Corp., 35 U.S.P.Q.2d 1125, 1131 (TTAB 1995). The testimony is not even of limited relevance since the exhibits show no usage of any "SC" mark that would allow the Board to draw any meaningful conclusions. In particular, 15 of the 16 Exhibits fail to indicate that anything bearing an "SC" mark was ever sold. [TD Corbett 55:9-15.] Because the exhibits do not show that anything was ever sold, they cannot show channels of trade. For example, even assuming a particular college sold anything bearing an "SC" mark, that sale could be made under circumstances reducing or eliminating confusion, such as a sale of uniforms to students engaged in intramural athletics at a particular school.

Likewise, the Exhibits do not allow Opposer or the Board to consider any critical information surrounding the alleged third-party use such as the amount of sales, advertising (if any), or length of use. Further, there is no information showing the market interface between the schools in the Exhibits and either Opposer or Applicant. Both Opposer and Applicant are large NCAA Division I universities. [StipFact ¶36, ¶ 82 (Carolina's enrollment is 37,800), ¶ 90 (California's enrollment is 32,000).] The schools in the Exhibits may provide excellent services to their students and communities, but Applicant has introduced no evidence to show how their size or whether their athletic teams receive extensive (or any) media coverage. To assume that any of the schools in the Exhibits would compete with either

Opposer or Applicant in connection with sales of “SC” merchandise would be to engage in pure speculation. It is considerably more likely that the schools in the Exhibits are local institutions that engage in either zero or *de minimis* merchandising than they compete with either Opposer or Applicant.

2. Objectionable Testimony: TD-Corbett 39:20-40:16 (Testimony as to Purchasers)

Over objection, Carolina sought to testimony from Mr. Corbett about the nature of purchasers of Carolina’s products. Mr. Corbett is an accountant who has primarily worked in auditing and financial oversight, where he continues to be responsible for handling capital finance issuing debt for buildings on campus and managing various subcontractors such as the food services, bookstore, and licensing contracts. [TD-Corbett 4:22-6:11.] Mr. Corbett was not designated an expert. Mr. Corbett purported to opine on the purchasers based on his experience “attending sporting events, out on the marketplace, visiting retailers, they tell us who buys our products.” [TD-Corbett 40:2-5.]

- Lack of Foundation/No Competence. While California has no doubt that Mr. Corbett has attended Carolina sporting events, the testimony in the record demonstrates that Carolina sells through a wide variety of channels of trade including department stores like Kohl’s, Belk and Dillards’, sporting goods retailers like Finish Line and Sports Authority, mass merchandisers like Wal-Mart, and more. Even if Mr. Walsh’s personal experience at sporting events could give him personal knowledge of the range of buyers at such sporting events, it does not address the consumers in the public at large.
- Lack of Foundation/No Competence. While Mr. Corbett does claim to go out once a month “to licensees and retailers just to kind of check and see what’s going on in the marketplace,” this is hardly a foundation on which to make a claim about the purchasers of Carolina’s goods in general and the “SC” branded goods in specific. There is no evidence that there is anything rigorous or systematic about Mr. Corbett’s visits, nor any evidence that Mr. Corbett pays any particular attention to the nature of the buyers. Moreover, sporadic visits to some retailers once a month or so cannot suffice to provide reliable information about the type of buyers who buy Carolina goods through all of the various channels of trade.

- Hearsay. To the extent that Mr. Corbett is merely repeating his understanding from conversation with retailers, he is repeating out of court statements for the truth of the matter and the evidence is not admissible.

3. Objectionable Testimony: TD-Corbett 90:9-23 (Alleged Lack of Actual Confusion Between the Parties)

Over objection, Carolina sought to elicit testimony in redirect from Mr. Corbett that he was not aware of any evidence of lack of actual confusion between California's products and Carolina's products. Carolina hires CLC to license on its behalf, who in turn licenses manufacturers, who in turn sell to retailers. [StipFact ¶¶ 51-54; O-Exs. 270-273; *see also* TD-Walsh 5:22-7:2, 7:19-10:8.] Mr. Corbett is therefore substantially removed from any actual confusion regarding items that are inexpensive to begin with. California objects to this testimony on the following legal grounds:

- Lack of Foundation/Irrelevant. Mr. Corbett is sufficiently far removed from the potential for confusion that his testimony lacks any basis on which to opine on this issue. To the extent that the question is Mr. Corbett's personal knowledge, his personal knowledge is irrelevant given how far Mr. Corbett's position puts him in the relevant chain.
- Improper Redirect. California in cross examination introduced evidence about various hats to demonstrate that – contrary to the prior testimony of Mr. Corbett – the University of South Carolina would and does license hats in a variety of colors other than Pantone 201 and black and moreover that the University of South Carolina licenses products without any other secondary identifier. This evidence in cross-examination does not provide any basis for Carolina to use re-direct to enter into the issue of actual confusion.

C. Objections to Testimony Deposition of C. "Kit" Walsh ("TD-Walsh")

1. Objectionable Testimony: TD-Walsh 24:8-28:16 and TD-Walsh 90:11-91:4 (Testimony Re: Alleged Mindset and Knowledge of Retail Consumers)

Over repeated objection, Carolina sought to elicit testimony from Mr. Walsh about the mindset and knowledge of the retail consumers of Carolina's goods. California objects to this testimony on the following grounds:

- Lack of foundation. Although Mr. Walsh is an executive with Collegiate Licensing Company (“CLC”), CLC works primarily to license manufacturers who sell to retailers who in turn sell to stores. [TD-Walsh 5:22-7:2, 7:19-10:8; StipFact ¶¶ 51-54; O-Exs. 270-273.] Mr. Walsh is therefore several steps removed from the retail consumer and has no basis on which to opine as to the mindset and knowledge of such consumers. No other purported basis was provided on which Mr. Walsh might purport to know the mindset and knowledge of the retail consumers.
- Speculation. To the extent that Mr. Walsh is speaking to the mindset and knowledge of retail consumers of Carolina’s products, he would merely be speculating about the state of another party’s thinking. He has no basis on which to know this.
- Improper expert opinion. Mr. Walsh was not designated as an expert by South Carolina. To the extent that such opinions would have been proper if put forth by an expert, Mr. Walsh was not identified as such and does not qualify as such.
- Calls for an improper legal conclusion (TD-Walsh 27:9-16 only). In addition to the above objections, Carolina’s question about “what level of care do purchasers of collegiate licensed products exercise” is also objectionable as calling for an improper legal opinion.
- Leading (TD-Walsh 90:23-91:3). In addition to the above objections, Carolina’s question about whether consumers would know that Carolina’s proposed stylization of the “SC” mark was connected to baseball was a leading question.

2. Objectionable Testimony: TD-Walsh 31:11-18 (Testimony on Likelihood of Confusion)

Over objection, Carolina sought to elicit testimony from Mr. Walsh that consumers would not be likely to confuse Applicant’s proposed stylization of the “SC” mark with California’s Baseball Interlock stylization of the “SC” mark. California objects to this testimony on the following grounds:

- Lack of foundation. Although Mr. Walsh is an executive with CLC, CLC works primarily to license manufacturers who sell to retailers who in turn sell to stores. [TD-Walsh 5:22-7:2, 7:19-10:8; StipFact ¶¶ 51-54; O-Exs. 270-273.] Mr. Walsh is therefore several steps removed from the end consumer and has no basis on which to opine as to the mindset and knowledge of such

consumer. No other purported basis was provided on which Mr. Walsh might purport to know the mindset and knowledge of the retail consumers.

- Speculation. To the extent that Mr. Walsh is speaking to the mindset and knowledge of consumers of Carolina's products, he would merely be speculating about the state of another party's thinking. He has no basis on which to know this.
- Improper expert opinion. Mr. Walsh was not designated as an expert by South Carolina. To the extent that such opinions would have been proper if put forth by an expert, Mr. Walsh was not identified as such and does not qualify as such.
- Calls for an improper legal conclusion. This questioning is also objectionable as calling for an improper legal opinion.

3. Objectionable Testimony: TD-Walsh 20:9-21:2 (Internet Back-End Fulfillment).

Over objection, Carolina sought to elicit testimony from Mr. Walsh about the number and dominance of companies who provide back-end fulfillment for Internet websites in the collegiate licensed products area. California objects to this testimony on the following ground:

- Lack of Foundation. No basis was laid on which Mr. Walsh would have any first hand knowledge of the companies that provide back-end fulfillment for Internet retail websites in the collegiate licensed products area.

4. Objectionable Testimony: TD-Walsh 31:20-32:18 ("Overlap" Testimony)

Over objection, Carolina sought to elicit testimony from Mr. Walsh whether "hats and apparel bearing South Carolina's baseball trademark overlap its products bearing the University of Southern California's 'SC' athletic interlock shown in Applicant's Exhibit 1." [sic.] Again over objection, Carolina also sought to elicit testimony whether "hats and apparel bearing South Carolina's baseball trademark overlap its products bearing the University of Southern California's baseball interlock shown in Applicant's Exhibit 2." California objects to this testimony on the following grounds:

- Vague and ambiguous. It is not clear whether this question is directed at likelihood of confusion between Carolina's proposed stylization of the "SC" mark and California's athletic interlock, or

whether it is directed to channels of trade, or geographic area, or whether “overlap” has some other meaning. The question is sufficiently ambiguous that the answer is meaningless.

- Lack of foundation. Although it is not clear what this question sought to elicit, no basis was provided on which Mr. Walsh could testify to any of the possible interpretations of this issue.

5. Objectionable Testimony: TD-Walsh 35:11-36:8, 37:8-13 (Nature of Merchandising by the Belk, Dillard’s And Kohl’s Department Store Chains)

Over objection, Carolina sought to elicit testimony from Mr. Walsh whether Carolina product sold by the Belk, Dillard’s and Kohl’s department stores would not be sold along side product from California. California objects to this testimony on the following grounds:

- Lack of foundation. There is no evidence that Mr. Walsh ever visited even one Belk, Dillard’s, or Kohl’s store, much less all of the Belk, Dillards, and Kohl’s stores carrying the Carolina product.

6. Objectionable Testimony: TD-Walsh 40:16-46:6 (Irrelevant Hats)

Carolina elicited testimony from Mr. Walsh identifying various hats from various schools around the country. California objects to this testimony as irrelevant on the following grounds:

The hats in Applicant’s Exhibit 13 are irrelevant for at least the following reasons. As the Federal Circuit has held, the “probative value of third-party trademarks depends *entirely* upon their usage.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (*italics added*). Since Mr. Walsh’s deposition includes no evidence regarding the usage of the hats, they have no probative value.

First, there is no evidence that any of the hats were ever sold, and if so, how many and through what channels of trade. For example, were the hats sold in the campus bookstore, or by a mass merchandiser such as a Wal-Mart, or through some other channel? There is no evidence that the hats were ever worn, and if so, by whom. There is no evidence of the length of use of any of the hats. And there is no evidence of the market interface between the two users that would affect the likelihood of confusion caused by their concurrent use. For example, one might infer (actually, speculate) that the simultaneous use of “V” marks means there isn’t confusion caused by that simultaneous use. But there is

no evidence if one university has objected to the other user's use, or if the hats are in fact causing confusion. In sum, the absence of any testimony regarding the use of the hats renders them irrelevant and therefore inadmissible.

Even if there were testimony regarding use, 12 of the 13 hats would still be inadmissible because they do not show a mark similar to "SC." The confusion caused (or not caused—one can only guess) by marks having nothing to do with the marks at issue in this proceeding is irrelevant. This is true generally, but is especially so since the hats in the Applicant's Exhibit 13 have so little in common with the "SC" mark at issue in this proceeding. Except for the Santa Clara hat, each of the hats in Exhibit 13 is for a mark consisting of a single letter, rather than two letters. And each hat has its own associated trade dress that makes it impossible to generalize from that hat to the present dispute. For example, one "V" hat has the "V" presented over crossed sabers, while the other has the "V" enclosed within a 5-point star. Perhaps these other indicia of source prevent confusion in the marketplace. But in any event, the mere existence of these hats, which is all Applicant's Exhibit 13 and Walsh deposition establish, do not make anything relevant to this case more or less likely, and the Board should therefore rule Applicant's Exhibit 13 inadmissible.

The Santa Clara hat is likewise inadmissible inasmuch as there is no evidence of how long that Santa Clara has used that mark, when (if at all) Santa Clara began merchandising that hat, or how (if at all) either Santa Clara or the hat have been marketed, etc.

7. Objectionable Testimony: TD-Walsh 88:25-90:2 (Alleged Lack of Confusion)

Over objection, Carolina elicited testimony from Mr. Walsh that he was not aware of any confusion between various school caps which appear largely identical on their face. California objects to this testimony on the following grounds:

- Lack of foundation. Although Mr. Walsh is an executive with CLC, CLC works primarily to license manufacturers who sell to retailers who in turn sell to stores. [TD-Walsh 5:22-7:2, 7:19-10:8; StipFact ¶¶ 51-54; O-Exs. 270-273.] Mr. Walsh is therefore several steps removed from the retail consumer. For Mr. Walsh to be aware of confusion, sufficient consumers would have to

mention confusion to the retail stores, and then sufficient retail stores would have to mention it to the licensees, and the licensees would then have to mention it to CLC. Since the retail price of these products is as low as \$5, that is highly unlikely. [TD-Walsh 67:14-16.]

- Irrelevant. The question of whether consumers find two different trademarks not at issue in this action to be confusingly similar is not relevant to the current litigation. California incorporates its relevance objection to the hats set forth above. In summary, there is no evidence that any of the hats were ever sold, and if so, how many and through what channels of trade. There is no evidence that the hats were ever worn, and if so, by whom. There is no evidence of the length of use of any of the hats. And there is no evidence of the market interface between the two users that would affect the likelihood of confusion.

II.

OPPOSER’S EVIDENTIARY OBJECTIONS TO EXHIBITS ATTACHED TO APPLICANT’S TESTIMONY DEPOSITIONS

The University of Southern California (“Opposer” or “California”) asserts the following objections to the evidence submitted by the University of South Carolina (“Applicant” or “Carolina”):

A. Exhibit 13 to the Testimony Deposition of C. “Kit” Walsh Taken March 1, 2006

Opposer objects to Applicant’s Exhibit 13 to the Testimony Deposition of C. (“Kit”) Walsh of March 1, 2006 on the grounds that the Exhibit is not relevant to any issue in this proceeding and is therefore inadmissible under F.R.E. 402. Opposer objected to the Exhibit on the grounds of relevance at the deposition. [Testimony Deposition of C. “Kit” Walsh (“TD-Walsh”) 46:12-15.] The Exhibit shows pictures of what are purportedly baseball caps bearing the logos from different universities. Mr. Walsh identified them as such. [TD-Walsh 40:16-46:6.] The Exhibit shows 13 hats. The first hat shows the letters “SC” and is purportedly affiliated with Santa Clara University. Leaving aside the first hat, the remaining hats consist of: two “A” hats, two “C” hats, two “M” hats, two “O” hats, two “S” hats, and two “V” hats. Each pair of hats is associated with two universities. For example, Mr. Walsh testified that the first “V” hat is associated with Virginia, and the second “V” hat is associated with Vanderbilt.

The hats in Applicant's Exhibit 13 are irrelevant for at least the following reasons. As the Federal Circuit has held, the "probative value of third-party trademarks depends *entirely* upon their usage." *Palm Bay*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (italics added). Since Mr. Walsh's deposition includes no evidence regarding the usage of the hats, they have no probative value.

First, there is no evidence that any of the hats were ever sold, and if so, how many and through what channels of trade. For example, were the hats sold in the campus bookstore, or by a mass merchandiser such as a Wal-Mart, or through some other channel? There is no evidence that the hats were ever worn, and if so, by whom. There is no evidence of the length of use of any of the hats. And there is no evidence of the market interface between the two users that would affect the likelihood of confusion caused by their concurrent use. For example, one might infer (actually, speculate) that the simultaneous use of "V" marks means there isn't confusion caused by that simultaneous use. But there is no evidence if one university has objected to the other user's use, or if the hats are in fact causing confusion. In sum, the absence of any testimony regarding the use of the hats renders them irrelevant and therefore inadmissible.

Even if there were testimony regarding use, 12 of the 13 hats would still be inadmissible because they do not show a mark similar to "SC." The confusion caused (or not caused—one can only guess) by marks having nothing to do with the marks at issue in this proceeding is irrelevant. This is true generally, but is especially so since the hats in the Applicant's Exhibit 13 have so little in common with the "SC" mark at issue in this proceeding. Except for the Santa Clara hat, each of the hats in Applicant's Exhibit 13 is for a mark consisting of a single letter, rather than two letters. And each hat has its own associated trade dress that makes it impossible to generalize from that hat to the present dispute. For example, one "V" hat has the "V" presented over crossed sabers, while the other has the "V" enclosed within a 5-point star. Perhaps these other indicia of source prevent confusion in the marketplace. But in any event, the mere existence of these hats, which is all Applicant's Exhibit 13 and Walsh deposition establish, do not make anything relevant to this case more or less likely, and the Board should therefore rule Applicant's Exhibit 13 inadmissible.

The Santa Clara hat is likewise inadmissible inasmuch as there is no evidence of how long that Santa Clara has used that mark, when (if at all) they began merchandising that hat, how (if at all) either Santa Clara or the hat have been marketed, etc.

B. Exhibit 51 to the Testimony Deposition of Kenneth Corbett Taken March 3, 2006

Opposer objects to Applicant's Exhibit 51 attached to the Testimony Deposition of Kenneth Corbett ("TD-Corbett") as hearsay to the extent that Applicant seeks to rely on the truth of any matter therein (particularly the affidavit of Thomas L. Stepp, the Secretary of the Board of Trustees for Carolina). Since Mr. Stepp was never presented as a witness in this action, any factual information that he attested to in the application is purely hearsay and cannot be relied upon by Mr. Corbett or Carolina in this action.

C. Exhibits 70-71 to the Testimony Deposition of Kenneth Corbett Taken March 3, 2006

Opposer objects to Applicant's Exhibits 70-71 attached to the Testimony Deposition of Kenneth Corbett. Applicant's Exhibits 70-71 consist of printouts from numerous online retail sites that previously contained evidence of actual confusion between Applicant's SC and Opposer's SC. [See Testimony Deposition of Elizabeth Kennedy ("TD-Kennedy") at 42:21-43:5, 44:21-45:6, 45:20-50:6 and Opposer's Exs. 3 and 6-13 thereto (showing the online retail websites evidencing actual confusion).]

Opposer objects to Applicant's Exhibits 70-71 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. These exhibits are supposed to show that on-line merchants who previously demonstrated confusion eventually learned the error of their prior behavior.

While Applicant contends that Applicant's Exhibits 70-71 demonstrate that there are no instances of actual confusion, Applicant's evidence only shows that some of the websites have been corrected. [Compare Opp. Exs. 3 and 6-13 with A-Exs. 374-380.] Since the question is whether third parties are likely to be confused, an instance of actual confusion is highly probative even if the error is later corrected, and does not negate the original confusion.

D. Exhibits 72-87 to the Testimony Deposition of Kenneth Corbett taken March 3, 2006

Opposer objects to Applicant's Exhibits 72-87 to the Testimony Deposition of Kenneth M. Corbett on the grounds that the Exhibits are not relevant to any issue in this proceeding and are therefore inadmissible under F.R.E. 402. Opposer repeatedly objected to the Exhibits at the deposition on the grounds of relevance. [See TD-Corbett 46:6-55:3.]

All of Applicant's Exhibits 72-87 are printouts of Internet websites of what purport to be third-party colleges or universities that include at least one picture of an article of clothing (including headwear) showing a version of California's SC mark. Mr. Corbett's only knowledge of these Exhibits comes from printing out the websites. [TD-Corbett 55:16-20 ("Q. Leaving aside what you know from the Web sites, do you have any other knowledge of these schools selling any merchandise that bears the letters SC? A. No.")]

In appropriate situations, the number and nature of similar marks in use on similar goods may have some bearing on the issue of likelihood of confusion. See *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). The evidence is generally of limited relevance, at best. For example, the Board discounted evidence of third-party use of arguably similar marks in an opposition to register a "star" design for restaurant services:

We see some other problems which limit the probative value of the evidence of third-party use. Many of the marks being used are less similar to opposer's marks than are applicant's marks. Further, applicant has not furnished any evidence regarding the extent of use of the marks by these third parties. The geographic locations of these restaurants, in many instances, are relatively obscure. Moreover, the pictures of these restaurants tend to indicate that the operations are small and local in nature.

Carl Karcher Enterprises Inc. v. Stars Restaurant Corp., 35 U.S.P.Q.2d 1125, 1131 (TTAB 1995). And as a federal court held, "the existence of other infringers is irrelevant and that a defendant trademark infringer cannot rely upon the wrongdoing of others to exculpate itself from its own infringing activities."

Council of Better Business Bureaus, Inc. v. Better Business Bureau of South Florida, Inc., 200 U.S.P.Q. 282, 297 (S.D. Fla. 1978).

The Corbett Exhibits are not even of limited relevance since they show no usage of an “SC” mark that would allow the Board to draw any meaningful conclusions. In particular, 15 of the 16 Exhibits fail to indicate that anything bearing an “SC” mark was ever sold. [TD Corbett 55: 9-15.] Because the exhibits don’t show that anything was ever sold, they cannot show channels of trade. For example, even assuming a particular college sold anything bearing an “SC” mark, that sale could be made under circumstances reducing or eliminating confusion, such as a sale of uniforms to students engaged in intramural athletics at a particular school.

Likewise, the Exhibits don’t allow Opposer or the Board to consider any critical information surrounding the alleged third-party use such as the amount of sales, advertising (if any), or length of use. Further, there is no information showing the market interface between the schools in the Exhibits and either Opposer or Applicant. As proved in this proceeding by both Opposer and Applicant, each are large NCAA Division I universities. [StipFact ¶¶ 35, 36, 82, 90.] The schools in the Exhibits may provide excellent services to their students and communities, but Applicant has introduced no evidence to show how their size or whether their athletic teams receive extensive (or any) media coverage. To assume that any of the schools in the Exhibits would compete with either Opposer or Applicant in connection with sales of “SC” merchandise would be to engage in pure speculation. It is considerably more likely that the schools in the Exhibits are local institutions that engage in either zero or *de minimis* merchandising than they compete with either Opposer or Applicant.

In summary, the lack of any meaningful information regarding the alleged use (much less the sale of goods) of “SC” by the schools in the Exhibits removes whatever minimal relevance the Exhibits might otherwise have. The existence of the websites in the Exhibits does not make any fact relevant to this proceeding either more or less probable, and so the Board should exclude them.

D. Exhibit 14 to the Testimony Deposition of Elizabeth West Taken March 2, 2006

Opposer objects to Applicant's Exhibit 14 attached to the Testimony Deposition of Elizabeth West on the grounds that the exhibit is not relevant to a factual determination in the proceeding. Applicant's Exhibit 14 is a June 1854 history exam showing use of "SCC" to refer to "S.C. College." Opposer objects to Applicant's Exhibit 14 because the exhibit does not establish trademark and service mark use of the letters "SC." As such, the described use on the history exam does not constitute any attempt by Carolina to identify itself with an "SC" mark in the mid 1800s.

E. Exhibit 15 to the Testimony Deposition of Elizabeth West Taken March 2, 2006

Opposer objects to Applicant's Exhibit 15 attached to the Testimony Deposition of Elizabeth West on the grounds that Exhibit 15 is not relevant to a factual determination in the proceeding. Exhibit 15 comprises an invitation issued by the S.C. College Clariosophic and Euphradian Societies for a commencement celebration in 1883; a commencement celebration invitation by the same societies for 1884; a commencement celebration invitation by the societies issued in 1885; a cover for an invitation by the societies in 1897 to their joint contest, which was a debating contest; and an 1891 invitation by the societies to the annual joint contest. [TD-West 10:13-11:7.]

Applicant's Exhibit 15 does not establish use of the letters "SC" by themselves inasmuch as this compilation of invitations depict "S.C. College" as well as the lettering "SCC." As such, the described use on the invitations does not constitute any attempt by Carolina to identify itself with an "SC" mark in the late 1800s.

F. Exhibit 16 to the Testimony Deposition of Elizabeth West Taken March 2, 2006.

Opposer objects to Applicant's Exhibit 16 to the Testimony Deposition of Elizabeth West on the grounds that Exhibit 16 is not relevant to a factual determination in the proceeding. According to Ms. West's testimony, Exhibit 16 is an 1898 photo of the Carolina football team wearing jerseys with the letters SC on them. [TD-West 12:20-13:16.] To the extent any of the jerseys pictured are supposed to depict the letters "SC," it is unclear from the photo. Moreover, even if a few jerseys depicted the "SC"

mark (which is not at all clear), such use does not demonstrate an intent by the institution to use the “SC” mark to identify itself.

III.
OPPOSER’S EVIDENTIARY OBJECTIONS TO EXHIBITS FILED
IN CONNECTION WITH APPLICANT’S NOTICES OF RELIANCE

Opposer the University of Southern California (“Opposer” or “California”) asserts the following objections to the trial exhibits submitted by Applicant, the University of South Carolina (“Applicant” or “Carolina”):

A. Exhibits Filed In Conjunction with Applicant’s Notice of Reliance No. 1

Opposer objects to Applicant’s Exhibits 88-89 attached to Applicant’s Notice of Reliance No. 1. Applicant’s Exhibits 88 and 89 together comprise one newspaper article published in *The State* on May 12, 1998, which features a photograph of Carolina baseball coach Ray Tanner wearing a baseball cap with the Carolina version of the SC mark. Applicant asserts that the exhibits are relevant in this action to demonstrate the fame of Applicant’s mark and Applicant’s use of the letters SC as a trademark and service mark.

Opposer objects to Applicant’s Exhibits 88-89 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. First, any use by Carolina of the SC mark after Carolina’s September 16, 1997 federal trademark application filing date is not relevant to any issue in dispute in this action. Second, the applicant’s general fame is not relevant, much less any alleged “fame” after the filing of the application. Finally, a photo of Carolina’s coach wearing an SC hat in a regional newspaper would not demonstrate fame in any event.

B. Exhibit Filed In Conjunction with Applicant’s Notice of Reliance No. 2

Opposer objects to portions of Applicant’s Exhibit 90 attached to Applicant’s Notice of Reliance No. 2 at 90.5 and 90.7. Applicant’s Exhibit 90 is an excerpt from the publication entitled *Remembering the Days An Illustrated History of the University of South Carolina*. Applicant asserts that the exhibit is

relevant in this action to demonstrate historical use of the letters “SC” by the state of South Carolina and its agency, the University of South Carolina.

To the extent the exhibit shows use of the letters SC by the state of South Carolina, Opposer objects that such use is irrelevant to these proceedings. The state does not license the mark. Moreover, the consuming public would not expect athletic goods to be endorsed by or affiliated with the state government as a whole. Of course, to the extent that particular educational institutions within the state use particular marks (particularly in connection with their athletic programs), then such use by the institutions may create a suggestion of affiliation, but use of the initials SC as an acronym by the state in connection with government departments, agencies, and on historical articles certainly does not amount to trademark or service mark use of the letters SC by the Applicant for athletic goods.¹ [DD-Corbett 105:21-106:1 at O-Ex. 252.31-32.] Prior use of mark does not extend to unrelated goods and services. *American Optical Corp. v. Autotrol Corp.*, 175 U.S.P.Q. 725 (TTAB 1972) (effect of such extension would be to bestow upon the prior user an impermissible “right in gross”). A trademark owner cannot extend the use of his mark to new products where the result would be likelihood of confusion in relation to the trademark of another. *Gilson*, Trademark Protection and Practice § 5.05. Put differently, the fact that one division of the state government may use the SC mark for classic governmental services does not give another division rights in entirely different goods since the consuming public would not consider the licensing of apparel as a governmental function. See generally *Proctor & Gamble Co. v. Johnson & Johnson, Inc.*, 485 F. Supp. 1185, 1199, 205 U.S.P.Q. 697, 709-10 (S.D.N.Y. 1979) (rejecting P&G’s

¹ It is also noteworthy that the Board observed in its July 31, 2003 Order refusing Applicant’s claim that there was a false suggestion of a connection under Section 2(a) of the Lanham Act between Opposer’s SC mark and the State of South Carolina that such a claim would have to be invoked by the state itself and not its agency. [Board’s July 31, 2003 Order at 22.] It stands to reason, then, that Applicant similarly cannot rely on uses of the acronym SC by the state of South Carolina to represent its own use.

claim that “SURE” mark for deodorant should be considered for tampons, given the fact that P&G treated tampons and deodorant in entirely separate divisions of the company).

Opposer cannot discern any evidence of historical use of the SC mark on Applicant’s Ex. 90.7, and therefore objects to the same on the grounds that nothing about this page is relevant to any issue in dispute in this action.

C. Exhibits Filed In Conjunction with Applicant’s Notice of Reliance No. 3

Opposer objects to Applicant’s Exhibits 91-105 attached to Applicant’s Notice of Reliance No. 3 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Applicant asserts that the exhibits are relevant in this action to demonstrate current and historical uses of the letters SC by the state government of South Carolina in governmental functions, including uses back to the foundation of the United States.

Applicant’s exhibits consist of contemporary and historic references to SC by the state of South Carolina, including use of SC as an abbreviation for “South Carolina” in official websites and on materials published by the state, as well as use of SC on state seals, Confederate flags, Revolutionary War uniforms, weaponry, and the like. To the extent the state uses “SC,” the state does not use SC on the goods at issue in this proceeding, namely clothing, nor does the state license the mark for such goods. Moreover, the consuming public would not expect athletic goods to be endorsed by or affiliated with the state government as a whole. *See generally* Opposer’s Objection to Notice of Reliance No. 2, *supra*.

D. Exhibits Filed In Conjunction with Applicant’s Notice of Reliance No. 4

Opposer objects to Applicant’s Exhibits 106-134 and 142-146 attached to Applicant’s Notice of Reliance No. 4 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Applicant asserts that the exhibits are relevant in this action to demonstrate (a) trademark and service mark uses of the letters SC by Carolina; (b) that the marks are not likely to be confused with

marks owned by California; and (c) that the nature of the goods are different because they are tied to fan-related products.

Opposer objects to Applicant's Exhibits 106-134 and 142-146 because the exhibits do not establish trademark and service mark use of the letters SC inasmuch as they depict marks other than the SC mark, and they demonstrate only *de minimis* use (at best) for brief periods, generally in connection with minor sports (such as freshman teams) on single individuals or rogue members of teams. Moreover, none of the exhibits support the proposition that Carolina's marks are not likely to be confused with California's marks, nor do they show use that is tied to fan-related products. Opposer's specific objections to Applicant's Exhibits 106-134 and 142-146 are detailed in the chart below.

Ex. No.	Carolina's Description of Exhibit	Objections / Response
106	June 1854 test showing use of "SCC" to refer to "S.C. College"	<ul style="list-style-type: none"> <u>Irrelevant.</u> The evidence submitted by Carolina is a history exam that reads "S.C.C. Freshman Class" on the test. The described use on the test does not constitute any use by Carolina to identify itself by "SC" as a mark.
107	1894-1898 Football scores using the term "S.C. College"	<ul style="list-style-type: none"> <u>Irrelevant.</u> The described use simply describes South Carolina College as "S.C. College" in listing a series of football scores and any use by Carolina to identify itself by "SC" as a mark.
108	1895-1899 Baseball scores using the term "S.C. College"	<ul style="list-style-type: none"> <u>Irrelevant.</u> The described use simply describes South Carolina College as "S.C. College" in listing a series of baseball scores and does not reflect any use by Carolina to identify itself by "SC" as a mark.
110	1900 Baseball Team photograph and roster showing use of the letters SC on uniform jackets	<ul style="list-style-type: none"> <u>Irrelevant.</u> The described use on uniform jackets does not demonstrate trademark or service mark use of the SC mark by Carolina in 1900. First, only two players are wearing jackets, and to the extent the jackets are supposed to depict the letters "SC," it is very unclear from the photo. Moreover, even if the jackets depicted the SC mark (which is not at all clear), a single photo of two players among 20 individuals wearing SC on their jackets does not demonstrate an intent by the institution to use the SC mark to identify itself in 1900.

Ex. No.	Carolina's Description of Exhibit	Objections / Response
112	1901 Varsity Baseball Team with a least one individual wearing a uniform with the letters SC on it	<ul style="list-style-type: none"> • <u>Irrelevant.</u> To the extent any of the uniforms pictured are supposed to depict the letters "SC," it is very unclear from the photo. Moreover, even if the one or a few uniforms depicted a SC mark (which is not at all clear), such isolated use is not evidence of an intent by the institution to use the SC mark to identify itself in 1901.
113	1901 Yearbook cover	<ul style="list-style-type: none"> • <u>Irrelevant.</u> Opposer cannot discern any evidence of use of the SC mark anywhere on Applicant's Ex. 113, and therefore objects to the same on the grounds that nothing about this exhibit is relevant to any issue in dispute in this action.
114	1901 Yearbook use of "SCC" to refer to "S.C. College"	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The evidence submitted by Carolina is a page from the 1901 yearbook that describes South Carolina College as "SCC." The yearbook page does not constitute evidence that Carolina as an institution was using the SC mark in 1901.
115	1902 Varsity Football Team photographs showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The photo depicts some type of interlocking SC lettering on a few players' sweaters. Such use by a few rogue players, even if it did inure to Carolina's benefit, would represent <i>de minimis</i> use, at best.
116	1902 Football Team photographs showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> To the extent any of the uniforms pictured are supposed to depict the letters "SC," it is very unclear from the photo. In fact, one player appears to have a marking made up of more than 2 letters, and no other markings are discernable in the photo. Moreover, even if the one or a few uniforms depicted the SC mark (which is not at all clear), such use does not demonstrate an intent by the institution to use the SC mark to identify itself.
117	1902 Junior Football Team photograph showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The described use on a few players' uniforms, worn by members of the junior football team, does not demonstrate an intent by the institution to use the SC mark to identify itself.
118	1902 Football Team photographs showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> To the extent any of the uniforms pictured are supposed to depict the letters "SC," it is very unclear from the photo. In fact, no markings are discernable in the photo. Moreover, even if the uniforms depicted the SC mark (which is not at all clear), such use does not demonstrate an intent by the institution to use the SC mark to identify itself.

Ex. No.	Carolina's Description of Exhibit	Objections / Response
119	1903 Varsity Baseball Team photograph showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> First, to the extent any of the uniforms pictured are supposed to depict the letters "SC," it is very unclear from the photo. In fact, one player appears to have a marking that consists of more than 2 letters, and no other markings are discernable in the photo. Moreover, even if the one or a few uniforms depicted the SC mark (which is not at all clear), such use does not demonstrate an intent by the institution to use the SC mark to identify itself.
120	1903 Varsity Baseball Team photograph with (back left) individual wearing uniform with the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> To the extent the individual in the back left corner has an SC on his sweater, it is very unclear from the photo. What is clear from the photo is that the majority of the players are wearing uniforms marked with the Carolina "C." Any isolated use of SC (which is not at all clear) by a rogue player does not demonstrate an intent by the institution to use the SC mark to identify itself.
121	1904 Yearbook drawing of a fan with "SCC" pennant	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The evidence submitted by Carolina is a pencil drawing from a yearbook depicting a man holding an "S.C.C." pennant. The described use does not constitute an intent by the institution to use the SC mark to identify itself in 1904.
122	1923 Cross Country Team photograph showing use of the letters SC on uniforms	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The photo depicts one member of the cross-country team with a vertical SC on his uniform, while the remaining team members are wearing uniforms marked with the Carolina "C." The fact that one rogue team member in a minor sport is wearing an SC does not demonstrate an intent by the institution to use the SC mark to identify itself in 1923.
125	1930 Baseball Team photograph with at least one individual wearing a uniform with SC mark on it	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The photo depicts one member of the freshman baseball squad with an SC on his uniform, while the remaining team members are not wearing uniforms marked with an "SC." The fact that one rogue team member from the freshman squad is wearing an SC does not demonstrate an intent by the institution to use the SC mark to identify itself in 1930.
126	1949 Track Team photograph using uniform with SC mark	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The photo of the single track athlete wearing a t-shirt with an SC on it does not demonstrate an intent by the institution to use the SC mark to identify itself in 1949.

Ex. No.	Carolina's Description of Exhibit	Objections / Response
143	1971 Baseball Team photograph showing use of the letters SC on uniforms	<ul style="list-style-type: none"> Irrelevant. Applicant's Ex. 143 is described as a photograph of the 1971 baseball team, but it appears to be a cut-out photo of one player on a white background with no additional information. This does not demonstrate trademark or service mark use of the SC mark by Carolina as an institution in 1971.
144	1973 Baseball Team photographs showing use of the letters SC on uniforms	<ul style="list-style-type: none"> Irrelevant. Applicant's Ex. 144 is described as baseball team photographs from 1973, but it is actually a single photo on one player wearing a jersey with a cut-off mark that may or may not read "SC." As such, the photo does not demonstrate an intent by the institution to use the SC mark to identify itself in 1973.
145	1992 Baseball Team photographs showing use of the letters SC on hats	<ul style="list-style-type: none"> Irrelevant. To the extent any of the hats pictured in Applicant's Ex. 145 are supposed to depict the letters "SC," it is very unclear from the photos (which look more like the letters "USC" than SC).
146	1993 Baseball Team photographs showing use of the letters SC on hats	<ul style="list-style-type: none"> Irrelevant. Applicant's Ex. 146 is described as baseball team photographs from 1993 showing use of the letters SC on hats, but it is actually a single photo on one player wearing an SC hat. The remaining photos feature the Carolina "C" on uniforms. As such, the photo does not demonstrate an intent by the institution to use the SC mark to identify itself in 1993.

E. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 5

Opposer objects to Applicant's Exhibits 148-151 attached to Applicant's Notice of Reliance No. 5 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Applicant asserts that the exhibits are relevant in this action to demonstrate (a) trademark and service mark uses of the letters SC by Carolina; (b) that the marks are not likely to be confused with marks owned by California; and (c) that the nature of the goods are different because they are tied to fan-related products.

Opposer objects to Applicant's Exhibits 148-151 because the exhibits do not establish trademark and service mark use of the letters SC inasmuch as they demonstrate only *de minimis* use (at best) for brief periods, generally in connection with minor sports (such as gymnastics, Karate, and tennis) on teams

or rogue members of teams. Moreover, none of the exhibits support the proposition that Carolina's marks are not likely to be confused with California's marks, nor do they show use that is tied to fan-related products.

F. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 6

Opposer objects to Applicant's Exhibits 158-164 attached to Applicant's Notice of Reliance No. 6. Applicant's Exhibits 158-164 all consist of Carolina's Baseball Media Guides for various years from 1998 through 2004. Applicant asserts that the exhibits are relevant in this action to demonstrate (a) uses of the letters SC by Carolina; (b) information about the University of South Carolina's baseball and softball teams; (c) that the marks are not likely to be confused with marks owned by California; (d) that the nature of the goods and services are different because they are tied to fan-related products and entertainment services; (e) that there is no overlap in channels of trade; (f) the fame of Carolina's mark; (g) the market interface between Applicant and Opposer; and (h) that there is not a potential for confusion.

Opposer objects to Applicant's Exhibits 158-164 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. First, the exhibits do not show anything about Carolina and/or California's channels of trade, and therefore do not demonstrate that the channels of trade are not overlapping (which they are). Second, the exhibits do not substantiate use in commerce on any of the goods described in Carolina's trademark application. Third, the exhibits do not assist in determining whether there is a likelihood of confusion between Carolina's SC trademark application and California's SC trademark registrations and common law uses. Fourth, the exhibits do not show the nature of Carolina's goods or the consumers for such goods. Fifth, the exhibits do not speak to the issue of priority to the extent they were created after the application at issue here. And finally, the fame of Carolina's mark after the application at issue is not relevant.

G. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 7

Opposer objects to Applicant's Exhibits 165-168 attached to Applicant's Notice of Reliance No. 7. Applicant's Exhibits 165-167 consist of agreements and orders relating to the concurrent use of Applicant's and Opposer's "USC" marks as well as a consent agreement between Opposer and Spelman College relating to a design mark that included an SC element. Applicant asserts that the exhibits are relevant in this action to demonstrate (a) that California has previously agreed that there is not a likelihood of confusion between similar trademarks of the Applicant and Opposer; (b) the length of time of concurrent use without confusion; (c) that California's SC mark is weak and California does not have the right to exclude others from the use of the letters SC; (d) that there are no instances of actual confusion; (e) the market interface between Applicant and Opposer; and (f) the extent of potential confusion.

Opposer objects to Applicant's Exs. 165-167 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. The exhibits pertain to a different set of marks for a completely different set of goods and services. The applications and registration at issue in this Opposition relate to collegiate goods marketed all over the country, whereas the marks that are the subject of Applicants Exs. 165-168 relate specifically to educational services (and to a mark which each party had consistently used for virtually all of the 20th Century). As such, the exhibits demonstrate nothing about confusion or the likelihood of confusion over the SC mark (which Carolina has used only for limited periods and in inconsistent manners), the weakness of the SC mark, or the market interface between Applicant and Opposer relating to the SC mark on collegiate goods.

Opposer objects to Applicant's Exs. 168 on the grounds that the exhibit is not relevant to a factual determination in the proceeding. The exhibit pertains to a design mark in which "SC" was only a minor element and which is very different than the stylized "SC" at issue here. In addition, the consent agreement specifically notes the existence of conditions that avoid any likelihood of confusion (such as

the fact that Spelman was a small women's college that did not employ channels of trade that would conflict with California).

H. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 9

Opposer objects to Applicant's Exhibits 170-171 attached to Applicant's Notice of Reliance No. 9. Applicant's Exhibits 170 and 171 consist of October 11, 2004 website printouts from Carolina's official athletic site and CNN Sports Illustrated referencing Carolina's baseball team. The Carolina athletic site printout includes Carolina's version of the SC mark in a banner, and the CNN Sports Illustrated printout includes a small photo of Carolina baseball coach Ray Tanner wearing a cap with the letters SC in Carolina's proposed stylization. Applicant asserts that the exhibits are relevant in this action to demonstrate the fame of Applicant's mark.

Opposer objects to Applicant's Exhibits 170-171 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Any public use by Carolina of the SC mark after the Carolina's September 16, 1997 application filing date is not relevant to any issue in dispute in this action.

I. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 13

Opposer objects to Applicant's Exhibits 213 attached to Applicant's Notice of Reliance No. 13 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Applicant asserts that the exhibits are relevant in this action to demonstrate historical use of the letters SC by the state of South Carolina and its agency, the University of South Carolina. Opposer objects for the reasons set forth above in connection with Notice of Reliance No. 2 (*i.e.*, the provision of governmental services in connection with the letters SC does not provide any basis on which consumers would consider athletic apparel to be licensed by the state government of South Carolina).

J. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 14

Opposer objects to Applicant's Exhibit 215 attached to Applicant's Notice of Reliance No. 14. Applicant's Exhibit 215 consists of an undated photo of a child's baseball jersey with the Carolina SC

Baseball Mark that is the subject of Carolina's trademark application. Applicant asserts that the exhibit is relevant in this action to demonstrate (a) trademark uses of the SC Baseball Mark by Carolina; (b) that the marks are not likely to be confused with marks owned by California; (c) that the nature of the goods are different because they are tied to fan-related products; and (d) that SC Baseball Mark is used on a variety of goods.

Opposer objects to Applicant's Exhibit 215 on the grounds that the exhibit is not relevant to a factual determination in the proceeding. First, the exhibit does not substantiate use in commerce by Carolina. Second, the exhibit does not assist in determining whether there is a likelihood of confusion between Carolina's SC trademark application and California's established SC trademark registrations and common law uses. Third, the exhibit does not show the nature of Carolina's goods or the consumers for such goods. And finally, the exhibit does not demonstrate that SC Baseball Mark being used on a variety of goods.

Moreover, because Applicant's Ex. 215 consists solely of a undated photo of a jersey, it is impossible to determine when the jersey was manufactured, and whether it was ever made available commercially. To the extent Carolina *may* have licensed or sold such jerseys, Opposer is only aware of such activities after Carolina's September 16, 1997 application filing date, and any such evidence of use *after* the application date is not relevant to any issue in dispute in this action.

K. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 16

Opposer objects to Applicant's Exhibits 217-357 attached to Applicant's Notice of Reliance No. 16 on the grounds that the exhibits are not relevant to any issue in this proceeding and are therefore inadmissible under F.R.E. 402.

Applicant says the proffered evidence shows (a) that there is a crowded field of university, college and professional team letter or initial trademarks; (b) the market interface between Applicant and Opposer; (c) the extent of potential confusion; and (d) the California's trademark rights in the letters SC

are extremely weak. [See Applicant's Notice of Reliance No. 16.] None of the exhibits, however, support Applicant's theories.

First, the exhibits of Applicant's Notice of Reliance No. 16 do not introduce evidence related to anyone's use of an SC mark. Rather, Applicant is apparently trying to establish a chain of reasoning where the first link is that other universities, colleges, and professional teams use trademarks consisting of letters that are similar to each other (but not to SC), and the second link is that this means that Applicant can use the same mark as Opposer. Neither of these links holds weight.

Applicant's Notice of Reliance No. 16 does not support the conclusion that other universities (or sports teams) use the same or confusingly similar marks. The Exhibits consist solely of abstracts of trademark registrations. The Trademark Trial and Appeal Board and its reviewing courts consistently hold that third-party registrations do not prove use of the registered marks or that the public is aware of the marks in the registrations. *Richardson-Vicks Inc. v. Franklin Mint Corporation*, 216 U.S.P.Q. 989 (TTAB 1982). Therefore, a mere recitation of third-party registrations does not prove any relevant third-party use. The Federal Circuit succinctly puts the matter as follows: "The probative value of third-party trademarks depends *entirely* upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (*italics added*). The exhibits in Applicant's Notice of Reliance No. 16 include nothing but third-party registrations and therefore say nothing about the actual use of those marks.

Applicant's failure to introduce any evidence concerning the actual use of the third-party marks is no mere technicality because without it Opposer (and the Board) cannot meaningfully gauge how these other marks relate—if at all—to this proceeding. In particular, there is no evidence that any of the cited marks are actually pronounced, rather than used only in writing. In fact, Opposer has elicited testimony from Applicant's witnesses to the contrary (*i.e.*, that many of the schools identified in these marks are *not* commonly known by these initials).

In this proceeding, Opposer has introduced evidence that Opposer is referred to as “SC.” Looking at the first entries in Applicant’s Notice of Reliance No. 16, it seems unlikely that the University of Arkansas or the University of Akron is referred to as “A.” Further, both the University of Arkansas’ and the University of Akron’s registrations are for designs. Applicant may speculate that those two schools can use a (different) “A” design without confusion. But in any event, as the exhibits in Applicant’s Notice show nothing about the actual use of any of the cited marks, they are irrelevant to show a lack of confusion even among the cited marks.

The second link in Applicant’s chain, *i.e.*, that other universities use marks similar to each other means that Applicant can use a mark similar to Opposer’s, is just as weak. As the Trademark Trial and Appeal Board and its reviewing courts hold, the existence of confusingly similar marks on the register (assuming that is the case) cannot aid an applicant to register another confusingly similar mark. *See AMF, Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 U.S.P.Q. 268, 269 (CCPA 1973) (“nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”). This oft-cited rule applies most directly when a party seeks to introduce registrations of other marks similar to a mark at issue in a proceeding. But it applies even more strongly when an applicant attempts to prove that some third-party marks, which are entirely different from the marks at issue in this proceeding, appear to be confusingly similar to each other. The Board has expressly criticized evidence of third-party marks that is different from an Opposer’s mark. *See Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 U.S.P.Q.2d 1125 (TTAB 1995) (“Moreover, none of the registrations is for the same mark as any of opposer’s marks.”). Again using the first entries of Applicant’s Notice as an example, it is simply irrelevant to this proceeding that that University of Arkansas and the University of Akron may or may not infringe each other’s rights.

Put differently, the fact that some companies in one line of goods or services have similar marks does not mean that every mark relating to those goods or services should be considered a crowded field. Many motels or hotels may use a term like “Good Nite” or “Good Rest” or “Good Slumber.” Does that

mean all other hotel providers (like Radisson or Four Seasons) only receive narrow protection for their marks? The entire idea is absurd.

Even if the Board were persuaded that evidence of third parties' registrations of marks entirely different from the marks at issue in this proceeding *could* be relevant, the actual marks in Applicant's Notice are notably inapposite to the SC mark in this proceeding and therefore irrelevant on that basis. Of the 141 entries in the table in Applicant's Notice, only a small handful relate to marks having more than one letter. And of those, still less relate to marks registered in typed form rather than marks registered in stylized form or with designs (this is significant in that Opposer is asserting a mark registered in typed form in this proceeding, among other marks). And of any entries that remain in Applicant's table, there is no evidence regarding whether one trademark owner consented to the registration by the other owner. All of this relates to the first point Opposer makes in objecting to the Applicant's Notice: a mere sampling of federal trademark registrations is not competent evidence regarding the use of any marks, much less evidence that makes anything in this proceeding more or less likely.

In sum, Opposer asks the Board to strike the proffered evidence in Applicant's Notice of Reliance No. 16 for lack of relevance because (1) federal registrations of third-party marks prove nothing as to the actual use of those marks, or their impact on the public, (2) the existence of arguably confusingly similar third-party marks that are dissimilar to the marks at issue in this proceeding is manifestly irrelevant, and (3) even if the proffered evidence were otherwise relevant, the registrations cited by Applicant are structurally dissimilar in that they are for (predominately) single-letter, stylized marks, and the Opposer and the Board can only guess what relationship exists between the various owners of the cited marks.

L. Exhibit Filed In Conjunction with Applicant's Notice of Reliance No. 18

Opposer objects to Applicant's Exhibit No. 373 attached to Applicant's Notice of Reliance No. 18 on the grounds that the exhibit is not relevant to any issue in this proceeding and is therefore inadmissible under F.R.E. 402.

Applicant says the proffered evidence shows (a) that the conditions under which and to whom sales are made are such that it is unlikely that there would be confusion between Applicant's mark and Opposer's mark; (b) the number and nature of similar marks in use on similar goods; (c) that there are no instances of actual confusion; (d) the length of time of concurrent use without confusion; (e) that California's SC mark is weak and California does not have the right to exclude others from use of the letters SC; and (f) the extent of potential confusion. [See Applicant's Notice of Reliance No. 18.] The exhibit, however, does not support Applicant's theories.

The Exhibit is described as a list of four year institutions in the United States; it comprises about 55 pages of listings. The table provides no information other than listing the names of institutions and the state in which they are located. It does not provide any information which would allow a reasonable fact finder to conclude that any of the names have been used as marks or even as trade names.

As discussed above in connection with other purported evidence in this case, it is settled law that probative value of evidence of third party use "depends *entirely* upon [the] usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (italics added).

The Exhibits in Applicant's Notice of Reliance No. 18 is nothing but a naked list of the names and locations of institutions. The list does not explain what marks, if any, the institutions use, how they use them, how long they have used them for, how the public perceives the use, or anything else. Because the list provides no information about use (or lack thereof) of the names of the institutions, it has no probative value and is irrelevant to this proceeding.

M. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 19

Opposer objects to Applicant's Exhibits 374-380 attached to Applicant's Notice of Reliance No. 19. Applicant's Exhibits 374-380 consist of printouts from numerous online retail sites that previously contained evidence of actual confusion between Applicant's SC and Opposer's "SC." [See

Testimony Deposition of Elizabeth Kennedy (“TD-Kennedy”) at 42:21-43:5, 44:21-45:6, 45:20-50:6 and Opposer’s Exs. 3 and 6-13 thereto (showing the online retail websites evidencing actual confusion).]

Applicant asserts that the exhibits are relevant in this action to demonstrate (a) that there are no instances of actual confusion; and (b) the extent of potential confusion.

Opposer objects to Applicant’s Exhibits 374-380 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. These exhibits are supposed to show that on-line merchants who previously demonstrated confusion eventually learned the error of their prior behavior.

While Applicant contends that Applicant’s Exs. 374-380 demonstrate that there are no instances of actual confusion, Applicant’s evidence only shows that some of the websites have been corrected. [Compare Opp. Exs. 3 and 6-13 with App. Exs. 374-380.] Since the question is whether third parties are likely to be confused, an instance of actual confusion is highly probative even if the error is later corrected, and does not negate the original confusion.

O. Exhibits Filed In Conjunction with Applicant’s Notice of Reliance No. 20

Opposer objects to Applicant’s Exhibits 381-382 attached to Applicant’s Notice of Reliance No. 20. Applicant’s Exhibits 381-382 consist of Applicant’s baseball and softball posters from the 2005 season. The posters display the Carolina SC Baseball Mark on either the poster itself, or on the uniforms of players featured on the posters. Applicant asserts that the exhibits are relevant in this action to demonstrate (a) uses of the letters SC by Carolina; (b) that the nature of the goods and services are different because they are tied to fan-related products and entertainment services; (c) that there is no overlap in channels of trade; and (d) that the conditions under which and to whom sales are made are such that it is unlikely that there would be confusion between Applicant’s mark and Opposer’s mark.

Opposer objects to Applicant’s Exhibits 381-382 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. First, any use by Carolina of the SC mark after the Carolina’s September 16, 1997 application filing date is not relevant to any issue in dispute in this action. Second, the exhibits do not substantiate use in commerce on any of the goods described in Carolina’s

trademark application. Third, the two posters do not show anything about Carolina and/or California's channels of trade, and therefore do not demonstrate that the channels of trade are not overlapping (which they are). And finally, the exhibits do not assist in determining whether there is a likelihood of confusion between Carolina's SC trademark application and California's SC trademark registrations and common law uses.

P. Exhibit Filed In Conjunction with Applicant's Notice of Reliance No. 24

Opposer objects to Applicant's Exhibit 402 attached to Applicant's Notice of Reliance No. 24 on the grounds that the exhibit is not relevant to any issue in this proceeding and is therefore inadmissible under F.R.E. 402.

Applicant says the proffered evidence shows (a) that California's SC mark is weak and California does not have the right to exclude others from the use of the letters SC; and (b) the extent of potential confusion. [See Applicant's Notice of Reliance No. 24.] The exhibit, however, does not support Applicant's theories.

The proffered evidence in Applicant's Notice does not contain a single reference to anyone's use of an SC mark. The evidence does show the unremarkable fact that Opposer's baseball team (referred to as "Southern Cal" in the Notice) has played the team of "Santa Clara" (that is, Santa Clara University). The proffered evidence is irrelevant for at least two reasons. First, and dispositively, it does not show any use of an SC mark by Santa Clara University. Second, even if it showed use of an SC mark by the Santa Clara baseball team, it still does not show use in connection with the sale of clothing or any other merchandise. Since the mere fact that Opposer's baseball team has played Santa Clara's team does not in fact support Applicant's theory of relevance or relate to any issue in this proceeding, the proffered evidence is irrelevant and the Board should exclude it. Finally, the proffered evidence is further inadmissible because it does not provide any evidence of how long Santa Clara has used "SC," what advertising (if any) it has engaged in, how the public perceives Santa Clara's alleged use, or any other evidence that would allow meaningful conclusions to be drawn from Santa Clara's alleged use.

Q. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 28

Opposer objects to Applicant's Exhibits 444-458 attached to Applicant's Notice of Reliance No. 28 on the grounds that the exhibits are not relevant to a factual determination in the proceeding. Applicant asserts that the exhibits, which comprise excerpts from Applicant's *Garnet & Black* yearbooks for various years, are relevant in this action to demonstrate (a) that there have been no periods of non-use of the letters SC by the Carolina; (b) that the marks are not likely to be confused with marks owned by California; and (c) that the nature of the goods are different because they are tied to fan-related products.

Opposer objects to Applicant's Exhibits 444-458 because the exhibits do not establish a lack of abandonment on Carolina's part of the SC mark inasmuch as they depict marks other than the SC mark, and they demonstrate only *de minimis* use (at best) for brief periods, generally in connection with minor sports (such as gymnastics, Karate, and tennis) on teams or rogue members of teams. Moreover, none of the exhibits support the proposition that Carolina's marks are not likely to be confused with California's marks, nor do they show use that is tied to fan-related products.

Ex. No.	Carolina's Description of Exhibit	Objections / Response
444	1930 Garnet & Black showing member of Freshman baseball squad wearing a jersey with the letters "SC."	<ul style="list-style-type: none">• <u>Irrelevant.</u> The described use on a single player's jersey does not represent any effort by the institution to identify itself with the "SC" mark. In fact, that single jersey appears to be a hand-me-down from a previous (and discarded) use of an SC mark.
445	1934 Garnet & Black showing gymnastics team members wearing a uniform bearing an SC over top a "U."	<ul style="list-style-type: none">• <u>Irrelevant.</u> The mark depicted on the gymnastics uniform is a highly stylized "USC," not "SC." As such, the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1934. Moreover, Ex. 445 describes Carolina gymnastics as a "minor sport." [App. Ex. 445.2.]

Ex. No.	Carolina's Description of Exhibit	Objections / Response
446	1935 Garnet & Black showing a drawing of the football stadium with the crowd forming the letters "SC." [Note, the exhibit also attaches a photo purportedly from the 1935 Garnet & Black yearbook of the 1898 Carolina football team which was not referenced in Carolina's description.]	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The described use on a drawing of the stadium does not represent trademark use of the SC mark. In addition, a conceptualized drawing of a football stadium where the letters SC are part of the drawing does not constitute evidence that <u>Carolina as an institution was using the SC mark in 1935.</u> • <u>Irrelevant.</u> The 1898 photo does not constitute evidence that Carolina as an institution was using the SC mark to identify itself in <u>1935.</u>
447	1937 Garnet & Black showing tennis players wearing tennis shirts bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the tennis team shirts, while practically illegible, appears to be a highly stylized "USC" mark, not an SC mark. Moreover, Carolina tennis was considered a "minor sport." [App. Ex. 376.21.] As such, the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1937.
448	1938 Garnet & Black referring to South Carolina under the mark "U. of S.C."	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The evidence submitted by Carolina is the cover of the yearbook that describes the University of South Carolina as the "U of S.C." The yearbook cover does not constitute evidence that Carolina as an institution was using the SC mark in 1938.
449	1939 Garnet & Black showing tennis players wearing tennis shirts bearing the letters SC and signage of South Carolina bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the tennis team shirts, while practically illegible, appears to be a highly stylized "USC" mark, not an SC mark. Moreover, Carolina tennis was considered a "minor sport." [App. Ex. 376.21.] As such, the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1939. • <u>Irrelevant.</u> The photo of a South Carolina Historical Marker on the Carolina campus and does not constitute evidence that Carolina as an institution was using the SC mark as a trademark or service mark in 1939. [See App. Ex. 97.2-97.3 explaining that South Carolina Historical Markers are "intended to mark historic places," and further explaining that all markers cast from 1936 to 1954 "have a circular devise at the top center bearing a palmetto tree and 'S C.'"]

Ex. No.	Carolina's Description of Exhibit	Objections / Response
450	1940 Garnet & Black referring to South Carolina under the mark "U. of S.C." and signage of South Carolina bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The evidence submitted by Carolina is the cover of a yearbook that describes the University of South Carolina as the "U of S.C." The yearbook cover does not constitute evidence that Carolina as an institution was using the SC mark in 1940. • <u>Irrelevant.</u> The photo of a South Carolina Historical Marker on the Carolina campus and does not constitute evidence that Carolina as an institution was using the SC mark as a trademark or service mark in 1940. [See App. Ex. 97.2-97.3 explaining that South Carolina Historical Markers are "intended to mark historic places," and further explaining that all markers cast from 1936 to 1954 "have a circular devise at the top center bearing a palmetto tree and 'S C.'"]
451	1941 Garnet & Black showing a[n] equipment chief and players wearing shirts bearing the letters "S.C.A.A."	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the shirts reads "S.C.A.A.," not "SC." There is no indication as to what "S.C.A.A." stands for, but in any event, the photos do not constitute evidence that Carolina as an institution was using the SC mark in 1941.
452	1943 Garnet & Black showing a football player wearing a shirt bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the shirt, while practically illegible, appears to be "S.C.A.A." followed by other letters or words. There is no indication as to what "S.C.A.A." stands for, but in any event, the photos do not constitute evidence that Carolina as an institution was using the SC mark in 1943. Moreover, even if the shirt depicted the SC mark, a single picture of a single player wearing such a shirt would not be evidence that Carolina as an institution was using the SC mark.
453	1948 Garnet & Black showing Coach Frank Johnson wearing a sweatshirt bearing "U. of S.C"	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the shirt reads "U. of S.C.," not "SC." As such, the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1948.
454	1973 Garnet & Black showing a student wearing a t-shirt bearing the letters SC on the left breast	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The described use on the student's t-shirt is not discernable to Opposer, and as such, Opposer believes that the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1973. • In addition, the text on this exhibit references a charitable group working with "S.C. inmates," which presumably refers to state inmates and not university inmates. [App. Ex. 454.2.]

Ex. No.	Carolina's Description of Exhibit	Objections / Response
455	1975 Garnet & Black back cover photograph of signage of South Carolina bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The photo of a South Carolina Historical Marker on the Carolina campus and does not constitute evidence that Carolina as an institution was using the SC mark as a trademark or service mark in 1975. [See App. Ex. 97.2-97.3 explaining that South Carolina Historical Markers are "intended to mark historic places," and further explaining that <u>all</u> markers cast from 1936 to 1954 "have a circular devise at the top center bearing a palmetto tree and 'S C.'"]
456	1979 Garnet & Black showing Karate student wearing a robe bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> The lettering depicted on the robe, while difficult to read, appears to read "UNIV of S.C.," not "SC." As such, the photo does not constitute evidence that Carolina as an institution was using the SC mark in 1979.
457	1980 Garnet & Black showing picture of football stands where female fan has on a hat bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> Attributing the described use on the fan's cowboy hat is purely speculative inasmuch as the photograph depicts a single picture of a single hat worn by a fan in a crowded stadium where no other similar hats are visible. There is no evidence about how or <i>when</i> this hat was created or sold. Moreover, it is very difficult to tell whether the hat reads "SC," "USC," or perhaps "BC." As such, Applicant has failed to present any evidence that Carolina as an institution was using the SC mark on hats in 1980.
458	1981 Garnet & Black showing picture of baseball stands where male fan has on a baseball hat bearing the letters SC	<ul style="list-style-type: none"> • <u>Irrelevant.</u> Attributing the described use on the fan's baseball cap is purely speculative inasmuch as the photograph depicts a single picture of a single cap worn by a fan in a crowded stadium where no other similar hats are visible, but where other Carolina marks are prominently featured, including the Carolina "C" and the Carolina Gamecock. There is no evidence of how or when this hat was created or sold. As such, Applicant has failed to present any evidence that Carolina as an institution was using the SC mark on hats in 1981.

IV.

OPPOSER'S EVIDENTIARY OBJECTIONS TO THE PARTIES' STIPULATIONS OF FACT

The University of Southern California ("Opposer" or "California") objects to the following facts in the parties' Stipulations of Fact filed with the Board on December 29, 2005. The parties specifically

reserved the right to challenge the relevance of any fact in the Stipulations of Fact, and California objects to each of the following facts on the grounds that they are irrelevant to any issue in this proceeding.

- **Stip. No. 57. On August 10, 1981, California and Carolina entered into an Agreement regarding each institution's use of the letters "USC."**

Objection: The parties' respective rights to the "USC" mark are not at issue in this proceeding and are not relevant to this proceeding. This proceeding relates solely to the parties' rights in SC marks.

- **Stip. No. 58. In February 1993, California entered into an Agreement with Spelman College.**

Objection: The Agreement between California and Spelman College is irrelevant because the ability of California and Spelman College to use their respective marks without a likelihood of confusion says nothing about the ability of Carolina to use the "SC" mark at issue in this proceeding without a likelihood of confusion. Moreover, since there is no evidence regarding the similarity of Spelman's mark, goods, channels of trade, or market interface compared to Carolina, any inference of Carolina's ability to use the mark based on the agreement between California and Spelman would be based on pure speculation.

- **Stip. No. 59. On June 10, 1996, California filed an application for concurrent use registration for the mark USC limited to certain geographical areas west of the Mississippi for educational and entertainment services.**

Objection: The parties' respective rights to the "USC" mark are not at issue in this proceeding and are not relevant to this proceeding. This proceeding relates solely to the parties' rights in SC marks.

- **Stip. No. 60. On October 1, 1997, California and Carolina entered into a Consent Agreement regarding registration and use of the mark "USC" in connection with each school's educational and entertainment services.**

Objection: The parties' respective rights to the "USC" mark are not at issue in this proceeding and are not relevant to this proceeding. This proceeding relates solely to the parties' rights in SC marks.

- **Stip No. 61. The October 1, 1997 Agreement was a settlement of the Concurrent Use Proceeding No. 1089.**

Objection: The parties' respective rights to the "USC" mark are not at issue in this proceeding and are not relevant to this proceeding. This proceeding relates solely to the parties' rights in SC marks.

- **Stip No. 84. Carolina's resident undergraduate tuition is \$6,914 (per academic year).**

Objection: The cost of tuition at either California or Carolina is not relevant to this proceeding. The cost of the goods in Carolina's application that is the subject of this proceeding is relevant, but the cost of tuition is unrelated to those goods.

- **Stip No. 85. Carolina's non-resident undergraduate tuition is: \$18,556 (per academic year).**

Objection: The cost of tuition at either California or Carolina is not relevant to this proceeding. The cost of the goods is Carolina's application that is the subject of this proceeding is relevant, but the cost of tuition is unrelated to those goods.

- **Stip No. 86. The name of Carolina's mascot is Cocky.**

Objection: The name of either party's mascot is not relevant, as the goods are not restricted in a way related to a mascot.

- **Stip No. 88. Carolina's athletic conference is the South Eastern Conference.**

Objection: The athletic conference is not relevant as this is not a concurrent use proceeding.

- **Stip No. 91. California's undergraduate tuition and mandatory fees (2005-06 academic year) are \$32,008.**

Objection: The cost of tuition at either California or Carolina is not relevant to this proceeding. The cost of the goods is Carolina's application that is the subject of this proceeding is relevant, but the cost of tuition is unrelated to those goods.

- **Stip No. 92. California's team name is the Trojans.**

Objection: The name of California's team is not relevant, as the goods are not restricted in a way related to a either California's or Carolina's team name.

- **Stip No. 93. California's mascots are Tommy Trojan and Traveler.**

Objection: The name of either party's mascot is not relevant, as the goods are not restricted in a way related to a mascot.

- **Stip No. 95. California is in the PAC-10 Athletic Conference.**

Objection: The athletic conference is not relevant as this is not a concurrent use proceeding.

- **Stip No. 96. On September 17, 1992, Spelman College filed a request for an extension of time to oppose Serial No. 74/094,681.**

Objection: Filing a request for an extension of time to oppose an application is not probative of anything other than a potential opposer is considering the possible effects of a registration on the potential-opposer's rights; this is not relevant to anything at issue in this proceeding.

- **Stip No. 97. On October 16, 1992 Spelman College filed a second request for an extension of time to oppose Serial No. 74/094,681 because settlement negotiations were taking place.**

Objection: In addition to the foregoing objection, the agreement between California and Spelman College is irrelevant because the ability of California and Spelman College to use their respective marks without a likelihood of confusion says nothing about the ability of Carolina to use the "SC" mark at issue in this proceeding without a likelihood of confusion. Moreover, since there is no evidence regarding the similarity of Spelman's mark, goods, channels of trade, or market interface compared to Carolina, any inference of Carolina's ability to use the mark based on the agreement between California and Spelman would be based on pure speculation.

- **Stip No. 98. On December 16, 1992, Spelman College filed a third request for an extension of time to oppose Serial No. 74/094,681 because a written settlement proposal had been made by Spelman College and negotiations were ongoing.**

Objection: California repeats its foregoing objection.

- **Stip No. 99. On January 15, 1993, Spelman College filed a fourth request for an extension of time to oppose Serial No. 74/094,681 because a written settlement proposal had been made by Spelman College and negotiations were still ongoing.**

Objection: California repeats its foregoing objection.

- **Stip No. 101. The letters "SC" are used as a part of the official state web address www.state.sc.us, which links to the official state website, www.mySCgov.com.**

Objection: The state of South Carolina's use of SC is irrelevant because (i) Carolina has not made a predicate showing that the use of SC by any branch of the state of South Carolina other than the University of South Carolina inures to South Carolina's benefit, and (ii) the official website has no relation to the goods recited in the application that is the subject matter of this proceeding.

- **Stip No. 102. Various state agencies have adopted the letters SC" as a part of their agency acronyms, such as SCDHEC or SCDOR.**

Objection: The state of South Carolina's use of SC is irrelevant because (i) Carolina has not made a predicate showing that the use of SC by any branch of the state of South Carolina other than the

University of South Carolina inures to South Carolina's benefit, and (ii) other agency acronyms have no relation to the goods recited in the application that is the subject matter of this proceeding.

- **Stip No. 103. The South Carolina Air National Guard has used "SC" on aircraft for decades.**

Objection: The state of South Carolina's use of SC is irrelevant because (i) Carolina has not made a predicate showing that the use of SC by any branch of the state of South Carolina other than the University of South Carolina inures to South Carolina's benefit, and (ii) National Guard services have no relation to the goods recited in the application that is the subject matter of this proceeding.

- **Stip No. 104. Since at least 1936, the letters "SC" have been used by the South Carolina Historical Marker Program on official markers around the state of South Carolina.**

Objection: The state of South Carolina's use of SC is irrelevant because (i) Carolina has not made a predicate showing that the use of SC by any branch of the state of South Carolina other than the University of South Carolina inures to South Carolina's benefit, and (ii) historical marker program services have no relation to the goods recited in the application that is the subject matter of this proceeding.

- **Stip No. 105. The letters "SC" are commonly used on maps as the geographical abbreviation for the state of South Carolina.**

Objection: Use on maps as a geographical abbreviation has no relation to the goods recited in the application that is the subject matter of this proceeding.

- **Stip No. 106. Since as least as early as the Revolutionary War, the South Carolina militia and State military have used the letters "SC" on clothing, uniforms and equipment.**

Objection: The state of South Carolina's use of SC is irrelevant because (i) Carolina has not made a predicate showing that the use of SC by any branch of the state of South Carolina other than the University of South Carolina inures to South Carolina's benefit, and (ii) militia and state military services have no relation to the goods recited in the application that is the subject matter of this proceeding.

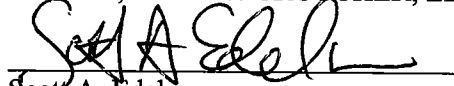
- **Stip No. 107. The letters "SC" are the official State Abbreviation assigned to the State of South Carolina by the United States Postal Service. Source: http://www.usps.com/ncse/abbr_state.txt.**

Objection: Use as a postal abbreviation has no relation to the goods recited in the application that is the subject matter of this proceeding.

Dated: August 31, 2006

Respectfully submitted,

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Reference no. 93107-00125

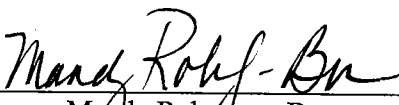
Opposition No. 91125615

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S SEPARATE STATEMENT OF OBJECTIONS** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 31st day of August, 2006.

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